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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,158	12/20/2001	Zhong-Min Wei	21829/230 (EBC-015)	9509

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EXAMINER	
KUBELIK, ANNE R	
ART UNIT	**PAPER NUMBER**
1638	

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	10/034,158	WEI, ZHONG-MIN	
	Examiner	Art Unit	
	Anne R. Kubelik	1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☒ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-9*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

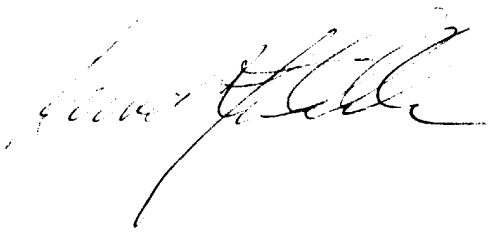
10. ☐ Other: _____

Continuation of 2. NOTE: New matter: a method of imparting drought stress tolerance to plants wherein the method first requires identifying a HR elictor that can impart drought tolerance has no support in the specification.

Continuation of 5. does NOT place the application in condition for allowance because:

102(e) rejections: Applicant urges that there was no evidnece that the plants of Wei I & II were exposed to drought, even if Mullet, Chaves and Bruce teach that some plants can grow in dorught conditons. Applicant urges that some plants are grown in hydroponic conditons, and submits Hassell et al. Applicant urges that because Wei I & II fail to identify the plant growth conditions and because it is known that plants can be grown under a wide variety of conditons, Wei I & II do not necessarily teach that the plants are grown under drought conditons. This is not found persuasive because one of skill in the art would know that plants grown in real world conditons would inherently be exposed to drought for at least some period of time. Hassell et al has been considered, but the reference simply supports in the assertion that plants are inherently grown in variety of conditons; additionally Hassell et al states that only a few plants are grown hydroponically. Applicant urges that new uses of known processes are patentable and states that unlike Bristol-Myers the instant methods are directed to a different purpose as compared to Wei I & II, has differnet method steps because the plants are grown under drought conditons and requires a particular result. This is not found persuasive because Eli Lilly and Co. v. Barr Laboratories Inc., 58 USPQ2d 1869 (CA FC 2001) at pg 1880 states "[F]luoxetine hydrochloride inherently blocks serotonin uptake upon administration. Therefore, no patentable distinction rests between administering fluoxetine hydrochloride for treatment of anxiety and inhibition of serotonin uptake by administration of fluoxetine hydrochloride." Thus, a method with a different purpose that inherently has the same result is not patentable over the first method, regardless of the result required. The method step argument is addressed above. Applicant urges that new claim 10 recites a limitation neither taught nor suggested by Wei I and II. This is not persuasive as this claim not taught or suggested in the instant specification either.

Double patenting rejections: Applicant urges that none of the claims of Qiu or Wei I or II specifiy that the plants are actually grown in drought conditons and that the evidnce cites shows that plants can be grown in a variety of conditons; Applicant urges that occasional results are not inherent, citing Mehl/Biophile. This is not found persuasive because that patent was found invalid over another reference because "No one disputes that guinea pigs have hairy backs" (pg 1306). As Mullet, Chaves and Bruce teach, a crops are exposed to at least some drought and one of skill in the art would know this. Additionaly see Eli Lilly and Co. v. Barr Laboratories Inc., 58 USPQ2d 1869 (CA FC 2001) at pg 1878: "[W]e limit our inquiry to an analysis of whether claim 7 of the '549 patent is invalid for obvious-type double patenting over claim 1 of the '213 patent.7 In accordance with the two-prong obviousness-type double patenting test demarcated in Georgia-Pacific, we first construe the claims at issue and determine the differences in subject matter between these two claims. The relevant portion of claim 1 of the '213 patent is directed to a method for treating anxiety in a human by administering an effective amount of fluoxetine or a pharmaceutically-acceptable salt thereof ... Claim 7 of the '549 patent covers a method of blocking the uptake of serotonin by brain neurons in animals by administering the compound fluoxetine hydrochloride ... A person of ordinary skill in the art would have recognized that fluoxetine hydrochloride is a pharmaceutically-acceptable salt of fluoxetine. In fact, hydrochloride salts are the most common pharmaceutically acceptable salts of basic drugs, and hence are obvious compounds. " Applicant urges that inhernecy is irrelevant to obviousness and that one of skill in the art would not know that the plants were rendered drought tolerance by tretament. This is not found persuasive. see Eli Lilly and Co. v. Barr Laboratories Inc., 58 USPQ2d 1869 (CA FC 2001) at pg 1880: [F]luoxetine hydrochloride inherently blocks serotonin uptake upon administration. Therefore, no patentable distinction rests between administering fluoxetine hydrochloride for treatment of anxiety and inhibition of serotonin uptake by administration of fluoxetine hydrochloride.



ANNE KUBELIK
PATENT EXAMINER